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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) | |
|--|--|---|-------------------|
| | | 659/793 (KC 15,071) | |
| I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office at facsimile no.: 571-273-8300 (Central number)) on <u>November 3, 2005</u> Signature <u>Amanda M. Church</u> Typed or printed name <u>Amanda M. Church</u> | | Application Number | Filed |
| | | 10/027,467 | December 20, 2001 |
| | | First Named Inventor | |
| | | Schmidt, et al. | |
| | | Art Unit | Examiner |
| | | 3724 | Alie |
| Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. | | | |
| This request is being filed with a notice of appeal. | | | |
| The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided. | | | |
| I am the | | <u>Amanda M. Church</u> Signature | |
| <input type="checkbox"/> applicant/inventor. | | Amanda M. Church Typed or printed name | |
| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98) | | | |
| <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>52,469</u> | | <u>312-321-4200</u> Telephone number | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | | <u>November 3, 2005</u> Date | |
| NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below. | | | |
| <input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted. | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Schmidt et al.

Serial No. 10/027,467

Filing Date: December 20, 2001

For AUTOMATIC SHEET THREADING
AND CUTTING DEVICE AND
METHOD

Examiner Ghassem Alie

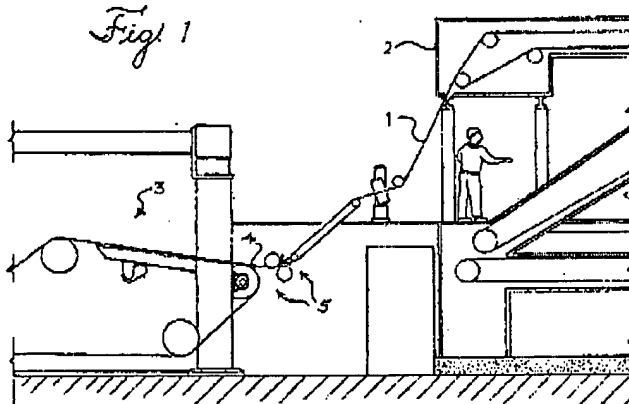
Group Art Unit No. 3724

REASONS SUPPORTING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the new pre-Appeal Brief Conference Pilot Program as described in 1296 OG 67 on July 12, 2005, Applicants respectfully submit the following arguments:

The invention, in general, relates to an automatic sheet threading and cutting device. Without limitation, the key claim feature that will be relied upon during appeal is the ability of this device to automatically divert a sheet of material away from one processing apparatus and direct it towards another processing apparatus.

This is illustrated in Fig. 1. As shown in Fig. 1, the processing apparatus is represented by element 3. The processing apparatus could be a roll winder, a slitting machine, an embosser, or a heat or chemical treater, etc. (Applicants' Specification,



page 7, l. 12-14). The sheet 1 may be diverted away from the processing apparatus 3 using the handling apparatus 5. The diverted sheet may be fed to a different processing apparatus (not shown) or may be direct to a scrap receptacle. (Applicants' Specification, p. 8, l. 12-13). The art cited by the Examiner, Sankaran, does not teach or suggest diverting a sheet of material from one apparatus to a separate and distinct apparatus or scrap receptacle. In fact, Sankaran teaches the use of a single "coiler" or an apparatus that winds a moving aluminum strip on to mandrels for storage. (Col. 3, l. 16-18). Each

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mandrel is part of the same apparatus. Because the prior art does not disclose the feature of diverting a sheet of material away from a processing apparatus, all of the Examiner's rejections should be withdrawn.

Rejections Under 35 U.S.C. § 103

Sankaran in view of Campbell

Claims 14-16, 20 and 22 stand rejected under 35 U.S.C. §103 over Sankaran (U.S. Patent No. 6,082,659) in view of Campbell (U.S. Patent No. 5,024,128). Sankaran and Campbell, either alone or in combination, do not provide for the diversion of a sheet of material away from a processing apparatus. Applicants submit that if elements 2, 22, and 34 of Sankaran are pieces of a processing apparatus, as suggested by the Examiner, (Final Rejection dated June 3, 2005, p. 4), then the processing unit also includes rolls 12 and 16, as well as mandrel 4. (Applicants' Request for Reconsideration, dated August 3, 2005, p. 2).

Sankaran teaches the use of a "coiler" or an apparatus that winds a moving aluminum strip on a mandrel for storage. (Col. 3, l. 16-18). According to Sankaran, all parts are desirably mounted on a common frame 6 which pivots from a centerline to enable the coil 32, mounted on mandrel 4, to be moved out of the way so that coil 42 may be formed on mandrel 2. (Col. 4, l. 35-36 and 51-52). After the aluminum strip 30 has been sufficiently wound around mandrel 4, the material is severed from the coil 32 on mandrel 4 to effectively complete the wrapping of the strip 30 to mandrel 4. (See Applicants' Request for Reconsideration, dated August 3, 2005, p. 3).

Once cut, the moving aluminum strip 30 is deflected onto the empty mandrel 2, not away from it. (Col. 5, l. 45-46). The coiler frame 6 is rotated slightly clockwise. When the coil on mandrel 2 has reached the desired size, the knife and roller assembly are retracted and the coiler frame 6, **including mandrels 2 and 4 with rolls 10 and 12**, are rotated clockwise to again position the empty mandrel 4 to the (prior) location of mandrel 2. (Col. 6, l. 14-20) (emphasis added). In fact, the sheet of aluminum is never diverted away from a processing apparatus, as argued by the Examiner. (Final Rejection, dated June 3, 2005, p. 4). The apparatus is actually moved from a full mandrel to an empty mandrel position, rather than the sheet changing directions from

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one apparatus toward a different apparatus. (Request for Reconsideration, dated August 3, 2005, p. 4-5).

In response to Applicants previous arguments, the Examiner states that "[s]heet 30 is directed away from mandrel roll 2 of the processing apparatus by roller 12." (Office Action dated June 3, 2005, p. 7). However, the fact that a reference may teach that a sheet may be diverted away from one portion of an apparatus to a different portion of the same apparatus does not satisfy the recitations of the instant claims. The sheet 30 is never directed away from the processing apparatus (including both mandrels 2 and 4).

Applicants claim a sheet of material passing between a retracted position and an extended position and being diverted away from a processing apparatus by passing between the nip rolls. Neither Sankaran or Campbell, alone or in combination, teach the claimed invention. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness and this rejection should be withdrawn.

Applicants further submit that it would not have been obvious to a person of ordinary skill in the art to replace roll 12 of Sankaran's coiling apparatus with the pair of nip rolls as disclosed by Campbell. The conclusory statements presented regarding obvious design choices of one skilled in the art are insufficient to establish a *prima facie* case of obviousness. MPEP 2143.01 states that, with reference to *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993):

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness without some **objective reason to combine** the teachings of the references. [Bold emphasis added]

The Examiner has not yet provided any evidence of a motivation or suggestion to modify the Sankaran reference, either from statements within the reference or from other documentary evidence on the record. Thus, the conclusory statement of obviousness "to one of ordinary skill in the art" would be insufficient to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. (Final Rejection dated June 3, 2005,

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p. 4). This is true even if a combination with another reference provided disclosure of each and every element of the claims, which they do not. On this basis alone, Applicants respectfully request the Examiner to withdraw this rejection.

Sankaran in view of Campbell and Lotto

Claims 17 and 18 stand rejected under 35 U.S.C. §103 over Sankaran in view of Campbell, and further in view of Lotto et al. (U.S. Patent No. 5,588,644). The applied references, alone or in combination, fail to provide each and every element of the claimed invention. Dependent claims 17 and 18 each depend from independent claim 14, including the diversion of a sheet of material away from a processing apparatus. As noted above with respect to claims 14-16, 20, and 22, Sankaran and Campbell, alone or in combination, do not disclose, teach or suggest the diversion of a sheet of material away from a processing apparatus. Lotto does not cure this deficiency. For this reason alone, this rejection should be withdrawn.

Moreover, the office action asserts that Lotto discloses a sheet of material that moves at a first speed and that is broken by the stress or tension created by a pair of nip rolls rotating at a second speed greater than the first speed. (Final Rejection, dated June 3, 2005, p. 5). The Office Action further asserts that it would be obvious to modify the combined apparatus of Sankaran and Campbell with the difference in speeds disclosed in Lotto. (Final Rejection dated June 3, 2005, p. 5-6).

The Examiner has not yet provided any evidence of a motivation or suggestion to modify the cited references, either from statements within or from other documentary evidence on the record. Thus, the conclusory statement of obviousness "to one of ordinary skill in the art" would be insufficient to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. On this basis alone, Applicants respectfully request the Examiner to withdraw this rejection.

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Sankaran in view of Campbell and Dambroth


Claims 19 and 21 were rejected under 35 U.S.C. §103 as being unpatentable over Sankaran, Campbell, and further in view of Dambroth (U.S. Patent No. 3,817,467). The Final Office Action asserts that the combination of Sankaran and Campbell teach or suggests each and every element of the claimed invention, except for a transfer blade having air jets and a sheet of material that is a fibrous web. The Examiner attempts to remedy this deficiency with Dambroth. (Final Rejection dated June 3, 2005, p. 6). Applicants point out that both claims 19 and 21 depend from claim 14 and therefore include the diversion of a sheet of material away from a processing apparatus. As noted above with respect to claims 14-16, 20, and 22, Sankaran and Campbell, alone or in combination, do not disclose, teach or suggest the diversion of a sheet of material away from a processing apparatus. Dambroth does not disclose, teach or suggest, nor has the Office Action asserted that Dambroth discloses, teaches or suggests the claimed feature. Accordingly, the Office Action fails to establish a *prima facie* case of obviousness and the rejections should be withdrawn.

Also, it should be noted that the Examiner has provided no motivation to combine or modify the cited references. As stated above, a conclusory statement does not satisfy the Examiner's burden to set forth a *prima facie* case of obviousness. On this basis alone, the rejection should be withdrawn.

Pending Claims 14-22 are patentable. Applicants respectfully request the Examiner grant early allowance of this application. The Panel is invited to contact the undersigned attorney for the Applicants via telephone if such communication would expedite this application.

Respectfully submitted,

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